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1634

OBLON
SPIVAK
McCLELLAND
MAIER
&
NEUSTADT
P.C.

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

RE: Application Serial No.: 09/749,998
Applicants: Isao KARUBE, et al.
Filing Date: December 29, 2000
For: METHOD FOR DETECTING DNA WITH PROBE
PNA
Group Art Unit: 1634
Examiner: J.A. GOLDBERG

SIR:

Attached hereto for filing are the following papers:

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENT (4 pp.)

Our check in the amount of 0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Norman F. Oblon
Attorney of Record
Registration No. 24,618



22850

(703) 413-3000 (phone)
(703) 413-2220 (fax)

Vincent K. Shier, Ph.D.
Registration No. 50,552

DOCKET NO.: 201482US0XCIP



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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF : :

Isao KARUBE, et al. : GROUP ART UNIT: 1634

SERIAL NO.: 09/749,998 : :

FILED: DECEMBER 29, 2000 : EXAMINER: GOLDBERG

FOR: METHOD FOR DETECTING DNA WITH PROBE PNA

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENT

In response to the Official Action dated March 12, 2002, Applicants elect, with traverse, Group I, Claims 1-20. In addition, Applicants elect, with traverse, the combination of a pair of primers and probe as described in Example 2, which includes the sense primer 1 (SEQ ID NO:4) and antisense primer 1 (SEQ ID NO:6) as a combination of a pair of primers (SEQ ID NO:2. Claims 1-20 read on the elected species.

REMARKS

The Office has restricted this application as follows under 35 U.S.C. §121:

Group I: Claims 1-20, drawn to methods and apparatus for detecting E-coli O-157;

Group II: Claims 1-8, drawn to a method of detection Vibrio parahaemolyticus; and

Group III: Claims 1-8, drawn to a method of detection of Salmonella.

In addition, the Office is requiring an election of a single combination of a pair of primers and a probe.

Applicants elect, with traverse, Group I, Claims 1-20. In addition, Applicants elect, with traverse, the combination of a pair of primers and probe as described in Example 2, which includes the sense primer 1 (SEQ ID NO:4) and antisense primer 1 (SEQ ID NO:6) as a combination of a pair of primers and the PNA probe of SEQ ID NO:2. Claims 1-20 read on the elected species.

Applicants traverse the Restriction Requirement on the grounds that Groups I-III contain Claims 1-8, and therefore should not be separated.

Further, the Office has not met its burden to support the Restriction Requirement.

MPEP §803 states as follows:

Examiners **must** provide reasons and/or examples to support conclusions, but need not cite documents to support the restriction requirement in most cases.

The Office merely states its conclusion that “the methods have different objectives and require different reagents.” However, Applicants submit that the Office has not provided sufficient reason and/or example to support this assertion.

Accordingly, the Restriction Requirement cannot be sustained and should be withdrawn.

Applicants traverse the Restriction Requirement on the additional grounds that the Office has not shown that a burden exists in searching all the claims of the present application.

Moreover, MPEP §803 states as follows:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on its merits, even though it includes claims to distinct or independent inventions.

Applicants submit that a search of all claims would not constitute a serious burden on the Office, particularly in view of the fact that the groups are classified in the same subclass (class 435, subclass 6).

Applicants respectfully traverse the Election of Species Requirement on the grounds that the Office has not provided any reasons, whatsoever, to support the conclusion of patentable distinctness. Rather, the Office has merely stated the conclusion.

Applicants make no statement regarding the patentable distinctness of the species, but note that for restriction to be proper, there must be a patentable difference between the species as claimed. MPEP §808.01(a). The Office has not provided any reasons or examples to support a conclusion that the species are indeed patentably distinct. Accordingly, Applicants respectfully submit that the restriction is improper, and Applicants' election of species is for examination purposes only.

Finally, with respect to the elected species, Applicants respectfully submit that, should the elected species be found allowable, the Office should expand its search to the non-elected species.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Restriction and Election of Species Requirement. Withdrawal of the Restriction and Election of Species Requirement is respectfully requested.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Norman F. Oblon
Attorney of Record
Registration No.: 24,618

Vincent K. Shier, Ph.D.
Registration No.: 50,552

PHONE NO.: (703) 413-3000

FAX NO.: (703) 413-2220

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